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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,648	01/07/2000	RONALD S. STEELMAN	54655USA1B/009	3344

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

F.K.

Office Action Summary

Application No.

09/479,648

Applicant(s)

STEELMAN ET AL.

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-31, 34-40 and 57-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-31, 34-40 and 57-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The indicated allowability of the claims and the finality of the last office action is WITHDRAWN in view of newly applied/discovered art/references, rejections based upon which follow.
2. The amendment filed 3-6-03 has been entered.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 37 and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how claim 37 differs from claim 57 as amended. Clarification is required – if they are identical in scope, one or the other should be canceled.

5. Claims 29-31, 34-37, 40, 57-59 and 61 are rejected under 35 U.S.C. 102(a/b/e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the admitted state of the prior art or Peacock et al. (US 5,800,919).

The admitted prior art (mainly described in the background part of the specification but also alluded to later in the detailed description) as well as Peacock et al. (note esp. col. 10, lines 42-50) evidence that it is known to provide a film including pressure sensitive adhesive on one surface as well as to heat this film (e.g. with a heat gun) to soften it and then press it against a substrate (e.g. one having rivets) using a tool such as a squeegee or rivet brush. As to the claim 34 requirement for a "Heat Neutral Pressure Source", as defined in the specification, this term is considered to require nothing more than that the pressure source not adhere to a softened film during

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application¹. Although the reference and admitted prior art do not explicitly indicate whether the tool sticks to the softened film, it is considered implicit that the tool used (e.g. rivet brush or squeegee) would not stick to the softened film as if it did it would obviously not effectively function in the described methods, i.e. in appropriately pressing the film. In any event, even if it were not considered implicit, it certainly would have been obvious for the artisan to select and utilize a tool to press the softened film that does not also stick to the softened film during pressing for the obvious and readily apparent advantage of avoiding film damage as well as tool fouling during the application process – only the expected results would therefore be achieved. Such therefore anticipates or renders obvious what is required by claims 30, 31, 34, 35, 40, 58 and 61. The claim 29 method is further considered to be the implicit or certainly obvious method of performing the known process. As to the thermal conductivity defined in claims 37 and 57, it is submitted that the substantial air gaps present in a typical brush would be expected to provide a relatively low thermal conductivity sufficient to teach or render obvious values as claimed, the burden properly shifting to applicant to establish otherwise. As to claims 36 and 59, the admitted prior art indicates that the conventional application includes use of a heat source, usually as a hot air gun or a torch. It would seem that a torch would satisfy the claimed requirement for infrared radiation. In any event, infrared heating is extremely well known and obvious.

¹ Although there is mention in the specification of the pressure source not adhering to the film “when nearly melted”, when read in light of the specification as a whole, this has been read as requiring no adherence to a “softened” film, it being noted that the specification indicates that heating to the softening point is heating “in accordance with the method of the present invention”. Further, it should be noted that there is insufficient detail provided in the original disclosure to limit the state of the film to anything beyond simply heat softened.

6. Claims 37, 38 and 57-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted state of the prior art or Peacock et al. (US 5,800,919) as applied above, and further in view of Preisler (US 3,861,988) and/or Coe (US 754,403) and/or Sadtler (US 1,672,093).

The known process of pressing is effected with a tool such as a squeegee or rivet brush but an open cell foam as claimed is not suggested. It however is submitted that in pressing a film type material to an irregular or textured surface, it is well known and conventional to use a flexible sponge or foam pressing element in order to effect the necessary adaptation of the film to the irregular substrate surface - Preisler (note esp. "16" and col. 2, lines 55-59), Coe (note esp. page 1, lines 8-25) and Sadtler (note esp. "7" and page 2, lines 87-92) are exemplary. To alternatively utilize a sponge or foam type pressing device as the tool to press the film to the surface would thus have been obvious and lead to only the expected results. Further, it is considered that the ordinary artisan would have certainly recognized that the film should not stick to the pressing means during application and would have selected the pressing elements accordingly, it not being beyond the skill of the ordinary artisan to select materials that have well known low adhesion properties (i.e. suitable material properties (i.e. flexible sponge/foam type materials) have been extremely well characterized and it is submitted that the ordinary artisan would be expected to be well aware of material properties including adhesion characteristics and would have been able to select accordingly). The claims directed to the requirement for a low thermal conductivity for the pressing means have also been included within this grounds of rejection as it is considered that

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foam or sponge type pressing means, which as noted, are considered to have been obvious alternatives in the prior art process, would be expected to exhibit low thermal conductivity characteristics.

7. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted state of the prior art or Peacock et al. (US 5,800,919) as applied above, and further in view of Moore (US 1,895,045) and/or Finke (US 4,261,783).

In the admitted prior art process, the pressing is apparently not effected with a roller. It however is taken by the examiner to be *extremely* well known per se to use rollers to apply pressure to effect bonding to a surface. Further, it is also known and conventional, when desiring to effect adherence to a textured or irregular surface, to apply the pressure using a roller that includes a flexible or conformable surface – Moore (note esp. “8”) and Finke (note esp. roller “201”) are exemplary. It therefore is submitted that it would have been prima facie obvious to effect the desired or necessary adherence of a film to a substrate using a roller for only the expected results. Further, it is again noted that it is considered that the ordinary artisan would have certainly recognized that the film should not stick to the pressing means during application and would have selected the pressing elements accordingly, it not being beyond the skill of the ordinary artisan to select materials (e.g. silicone based or Teflon coated) that have *well known* low adhesion properties.

8. Claim 30 is rejected under 35 U.S.C. 102(b) as being anticipated by Alfter et al. (US 3,962,016) or Boyd et al. (US 4,511,425) or Werstlein (US 3,853,669).

Alfter et al. discloses a device for application of films to a surface including a pressure roller "6" coated with Teflon as well as a heat source "7". Such is considered to be clearly capable of applying heat to a film as claimed and further the Teflon coated pressure roller would be expected to avoid adherence. The reference to a "kit" is considered to require that the elements have a degree of association such that they are intended to be used together, this thus not considered to define or require any additional structure beyond that shown in the reference.

Boyd et al.² discloses a device for application of films to a surface including a resilient pressure pad (60) formed of a silicone elastomer adapted to release a softened film as well as various heat sources both within the pad as well as at e.g. "45". Such is considered to be clearly capable of applying heat to a film as claimed and further the pressure pad is designed to release the heated film upon application to a substrate. The reference to a "kit" is considered to require that the elements have a degree of association such that they are intended to be used together, this thus not considered to define or require any additional structure beyond that shown in the reference.

Werstlein also discloses a device for pressing plastic material including heating means and a pressure roller that applies a softened film to the substrate, it being considered that the reference suggestion of a smooth seam would have been understood by the artisan as an indication that the film is not sticking to the roller. In

² It is noted for the record that since this reference is apparently directed to applying a label to a substrate that is apparently only adhesive when in the heated state, it has been considered that this reference is *not* suggesting application of a label having a *pressure sensitive adhesive* as defined or required in the other claims of record. This reference has therefore not been applied against the other claims in light of this distinction.

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any event, it should also be noted that claim 30 requires no particular film, it being considered that sticking depends in part on the type of film applied, it being considered that almost any pressure source can read on the claimed "heat neutral pressure source" as there is almost necessarily some types of films for which the pressure source would have the *capability* of not sticking to.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
March 31, 2003